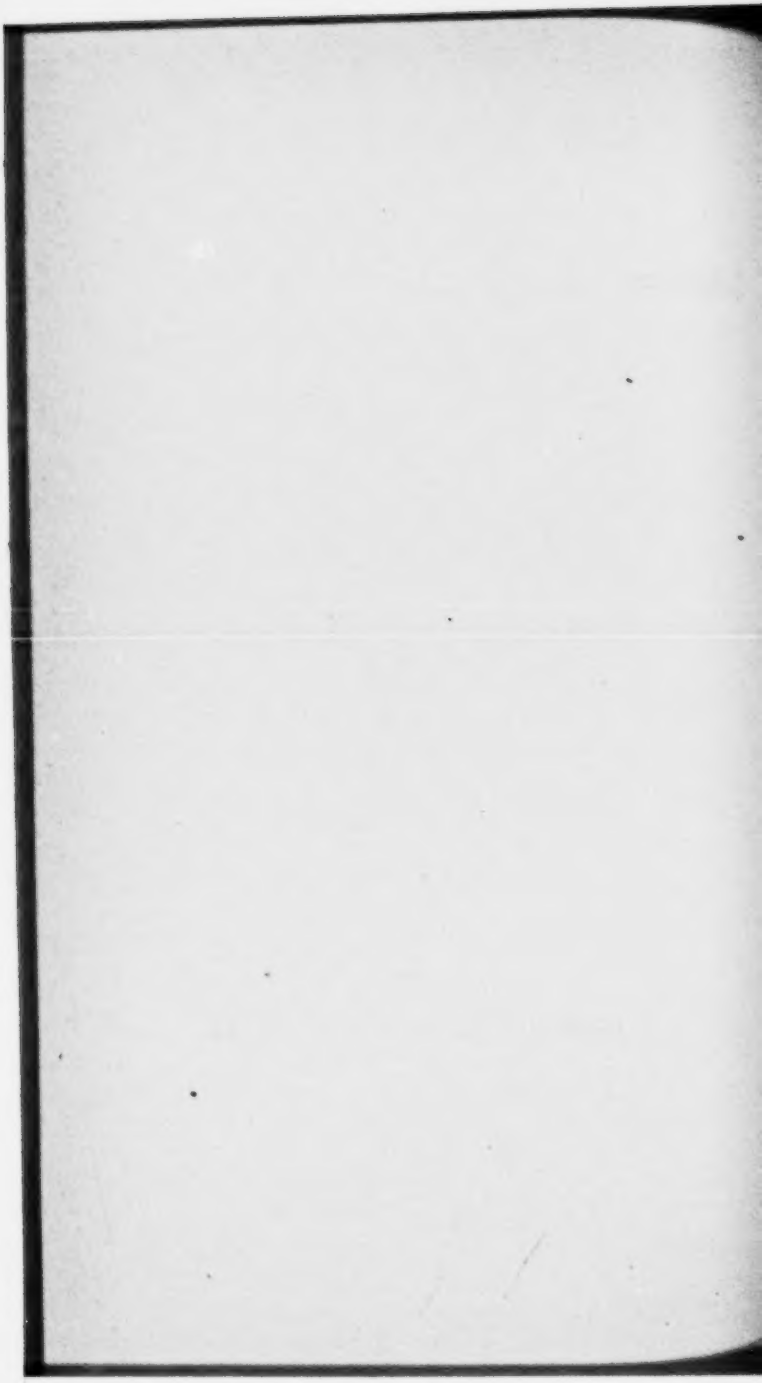


FILED
FEB 24 1903
JAMES H. McKENNEY,
Clerk.

FILE COPY.

Supreme Court of the United States.

OCTOBER TERM, 1902.

NO. 181.

JOHN A. BRILL and the J. G. BRILL COMPANY,
Complainants and Petitioners,

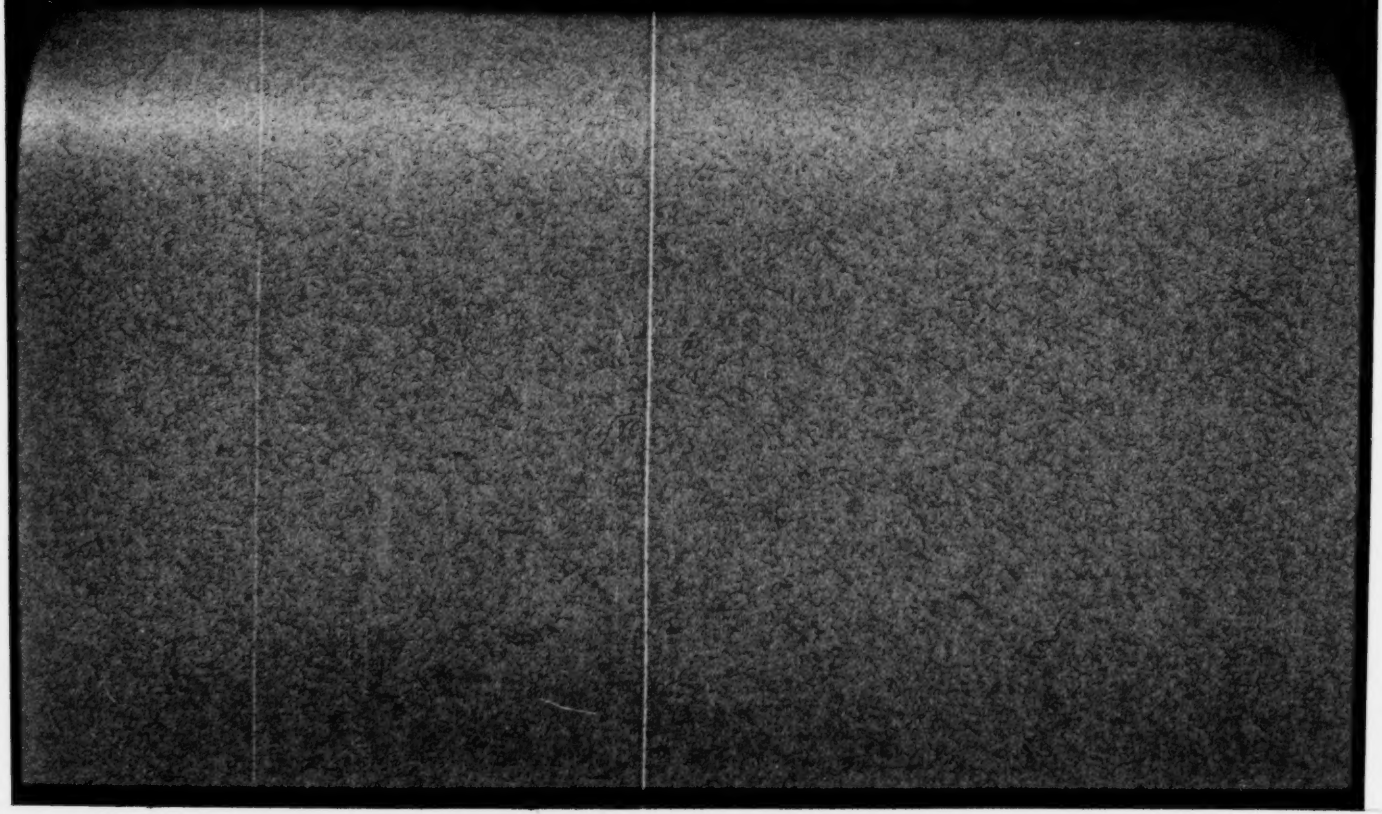
vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY, *et al.*,
Defendants and Respondents.

BRIEF FOR RESPONDENTS.

CHARLES H. DUELL,
WILLIAM A. MEGRATH,
Counsel for Respondents.

The M-B Press, 278 Greenwich St., N. Y.



In the United States Supreme Court

JOHN A. BRILL AND THE J. G. BRILL COMPANY, *Petitioners,* vs. THE PECKHAM MOTOR TRUCK & WHEEL COMPANY, *Respondents.*	*In Equity.*

BRIEF FOR RESPONDENTS.

STATEMENT OF THE CASE.

This suit was originally brought in the United States Circuit Court for the Southern District of New York, by John A. Brill and the J. G. Brill Company for an alleged infringement of letters patent No. 478,218 granted to George M. Brill July 5, 1892, for improvement in Car Truck.

A motion for a preliminary injunction to restrain the Defendants from infringement of the first and second claims of the patent was made and granted. An appeal being taken, the Circuit Court of Appeals (Judges Wallace, Wheeler and Thomas sitting) by unanimous vote reversed the order granting the injunction and remanded the case to the Court below with instructions to vacate the injunction and to dismiss the bill with costs. (Record 150-154; 108 F. R. 267.)

The motion for injunction and the appeal were heard on the record in an earlier suit brought under this patent, in the Southern District of New York, by Brill, against the Third Avenue Railroad Company, which resulted in a decree for the Complainant for an injunction as to Claims 1, 2, 9, 10, 11, 12, 14 and 27, and from which no appeal was taken, which record was further supplemented by further depositions, documents and other exhibits. (Record, pps. 136, 137.)

A petition for a rehearing was presented and granted. Upon such rehearing the majority of the Court was of the opinion that no modification of the order should be had and it was so ordered. (Record, 154-167, 110 F. R. 377.)

A petition for a writ of *certiorari* was presented to this Court and granted, and the cause is now presented to this Court as a review of such decision of the Circuit Court of Appeals.

THE PATENT.

Petitioners claim infringement of Claims 1 and 2.

> 1. In a motor-truck, the combination, with a stationary frame supported upon the running-gear, said frame having sections extending outwardly from the axle, of a movable frame supported upon said truck, spiral springs located between the movable and stationary frames, and elliptical springs located between the extended sections of the said rigid frame and the movable frame, substantially as described.
>
> 2. In a truck, a spring-supporting frame supported upon the running-gear by saddles and having sections extending outwardly from the axles, a movable frame having like extensions, spiral springs located between the saddles and movable frame, and elliptical springs located between the spring supporting frame and the movable frame, substantially as described.

Construction of Claims by the Circuit Court of Appeals.

In considering these claims the Circuit Court of Appeals held that they must be limited to the combination specified, in which "spiral springs and ellipitical springs are so arranged that the latter are not brought into action until after the former have begun to compress."

There can be no quesion but that this construction, placed upon these claims by the Circuit Court of Appeals is the correct one.

FIRST. The specification of the patent forbids any broader construction to be placed upon these claims.

The specification of the patent speaks for itself. On page 1, lines 63-75, it is said:

> "The spiral springs, which are supported by or about the axle-boxes, normally take the weight of the car.
>
> "Between the extended sections of the upper chord and the side beams I place elliptical springs, which *prefcrably* extend longitudinally of the truck and which are so disposed that they will not be brought into action until the weight of the load on the axle-box springs begins to depress said springs abnormally. Then the elliptical springs begin to act, and assist the spiral springs in resisting the pressure of the load."

We have here then a combination of spiral and elliptic springs in which the spirals normally carry the weight of the car; and elliptic springs *preferably* longitudinal of the car, which are not brought into action until the spiral springs are abnormally depressed.

Again, on page 1, line 101:

> "And an adaptation of my invention consists in making the axle-box springs comparatively weaker and slower than has formerly been done, and to place elliptical springs in such a way as to assist the spiral springs in resisting the abnormal depression of the car and in equalizing the end oscillation of the same, the elliptical springs being slower in their action than the spiral springs."

Here we find other characteristics of the combination. The spiral springs are to be weaker than had been customary; the elliptic springs are to be so placed as to assist the spiral springs in resisting abnormal depression; and the elliptic springs are to be slower in their action than the spirals.

At page 2, line 116, we read:

> "It is, therefore,clear that more than ordinary load is intended to be carried on this structure, and for this reason more than ordinary devices for spring supporting the car-body are necessary. To this end I supplement the axle-box springs by placing elliptic springs of slower action between the extended portions or sections of the side beams and upper chord, and so arrange them in respect to each other that the elliptical springs will not come into play until the axle-box springs have begun to compress, and the action of the spirals in lifting the car-body is continued after the elliptic springs have ceased to act. The devices which secure the elliptical springs between the side beams and the upper chord are devised to permit one end of the upper chord to approach the side beams and the other end to be elevated, as will occur in the act of oscillation, one set of elliptic springs being compressed while the other remains in its normal condition."

Here again we have a combination in which the elliptic springs are slower than the spirals; which do not come into action until after the spirals have begun to compress; and the elliptics are so fastened to the structure that when one end of the car body goes down in galloping, the elliptic at that end will be compressed, while the elliptic at the other end remains in its normal condition. In other words, the elliptics are fastened underneath to the truck frame, but are not fastened on top to the car body, as appears more plainly on page 3, line 25, where we read:

> "From the foregoing structure, it will be seen that the springs (elliptic) are rigidly secured to the side beams. They are, however, not secured rigidly to the upper chord (the car-body), so that any upward movement of it will not affect them. The upper chord (the car-body), however, is provided with means for retaining the upper half of the springs

(elliptics) perpendicular to the side beams."

While the "upper chord" is not the "car-body," strictly speaking, still as it is so bolted to it as to be absolutely integral with it when the car is ready for use and partakes of its every motion, it was thought the true bearing of the quotation would be more apparent if those words were interpolated.

Then follows on page 3, lines 34-45, a description of a saddle or fork, which is attached to the car-body (upper chord) in such a way as to straddle the top of the elliptics, and so arranged that the bottom of the saddle will bear upon the elliptics and compress them only at that end of the car which may be depressed, and only then; whereas, when the end of the car-body rises, as in galloping, the saddle rises with it leaving the upper side of the elliptic entirely free from compression and wholly out of action.

Again, on page 3, line 69, we read:

> "When, by reason of excessive loading of the car-body, and consequent depression of the springs (spirals) a portion of this action would be taken on the springs (elliptics) supported on the ends of the side beams. When the excessive loading is not present, the springs on the ends of the side beams act as buffers, the ordinary action of the car-body on the truck being taken up by the spiral springs."

The combination of the springs in the Patent-in-Suit therefore, is (A) one in which the spiral springs near the axle-boxes carry the whole load under normal conditions, while (B) the elliptic springs only come into action after an abnormal load has considerably compressed the spirals, or at the descending end of the car when the car gallops. Also (C) the elliptics are to be rigidly secured only at their bottom to the truck-frame; while (D) their upper connection with the car-body is a loose connection not touching the car-body at all under normal conditions, permitting the car-body to rise and leaving the elliptic spring behind, only again to come into action when the car is depressed below the normal. In other words, the elliptic springs are wholly inoperative and might just as well

have been omitted from the structure, except when the car-body or its ends are abnormally depressed.

The Circuit Court of Appeals, after reading the specification, was compelled to say:

> "If the patentee had attempted to do so, it would have been difficult to frame a specification which more industriously sets forth as essential to his invention such a construction and arrangement of the spring devices that the elliptic springs will not be brought into play until the spiral springs have been compressed by the weight of the car-body and the added load, 'until the weight of the load on the axle-box springs begins to depress said springs abnormally.' This characteristic of the invention must be imported into the claims, and would have to be if the qualifying term, 'substantially as described,' had not been incorporated into them."

(Record p. 153, 108 F. R. 271.)

Claims 1 and 2, literally construed, do not correctly represent the patentee's invention as disclosed by the specification, and recourse properly was had to the specification by the Circuit Court of Appeals in construing the claims.

Pope Mfg. Co. vs. *Gormully, &c. Co.*, 144 U. S. 238.
Boyden Co. vs. *Westinghouse*, 170 U. S. 537.

SECOND. The proceedings in the Patent Office while the application for the patent was pending, as shown by the file wrapper and contents ,forbid any broader construction being placed upon these claims. The File Wrapper of the Patent-in-Suit is printed in full on page 222a of Defendants' Record in the Third Avenue Case, which is before the Court.

When we turn to this File Wrapper and investigate the history of this Patent in the Patent Office, we find that in order to enable the Patentee to obtain Claims 1 and 2 of the Patent, to escape the anticipatory references cited against these claims, the Patentee limited himself to the specific combination of spirals and elliptics so coacting as to have the specific functions stated in the preceding subdivision.

The File Wrapper and Contents show that the case, as originally filed, embodied a large number of claims.

On August 24th, 1891, the Patent Office transmitted the following letter of Rejection (See Defendants' Record Third Avenue Case, p. 240, fol. 718).

> "By reference to Peckham 419,876, January 21, 1890, it will be noticed in Figs. 4, 5 and 6 that semi-elliptic springs are used for the end of the car. It is held that no patentable difference exists in substituting an elliptic spring for the spring named, and especially in view of the following patent, wherein elliptic springs are shown for the end of the car, Taylor, 437,167 Sept. 23, 1890. The arrangement of the upper and lower frames and the springs is in other respects very similar to Robinson, No. 451,952, May 12, 1891. (These references are all in trucks, street car and motor.) In view of the patent cited, therefore, Claims 1, 2, 3, 4, 11, 12, 13, 16, 17 and 25 are rejected."

The above Peckham Patent was that cited in Judge Shipman's Decision.

On September 21st, 1891, the Applicant filed the following answer to this rejection. See Defendants' Record. Third Avenue Case, p. 241, fol. 723:

> "Robinson of record does not show nor describe the arrangement of springs of varying tension, nor springs adapted to supplement the action of other springs, nor springs coming into action before the other, nor the combination of spiral and elliptic springs for supporting the movable frame of the truck.
>
> "Taylor of Record does not show nor describe springs of varying tension interposed between the movable frame and stationary frame, nor does he show a movable frame. His truck has but one frame, and the springs that he shows are secured to the car-body directly. Nor does he show the combination of elliptical and spiral springs, interposed between the movable and stationary frame of the truck, nor does he show one series of springs adapted to act before the other, one supplementing the other.
>
> "Peckham describes nothing about one set of springs being quicker or slower than the other, nor one series of springs being adapted to act prior to the other series."

Again and again the Applicant insists upon the peculiar method of coaction and time of operation of his combination of spiral and elliptic springs, and upon these differentiations avoided the anticipatory references hereinbefore mentioned.

It is elementary, and laid down in decisions almost without number, that where an Applicant has insisted upon a certain construction of his specification and claims in order to overcome anticipatory references cited against the application in the Patent Office and thus obtains his patent, he cannot thereafter be heard to claim a broader or different construction. Citations of authorities seems unneccessary.

If these decisions correctly set forth the Patent Law then it would seem unavoidably to follow that the Patent-in-Suit is limited to a combination of elliptic and spiral springs in which "one set of springs being [is] quicker or slower than the other," and "one series of springs being adapted to act prior to the other series."

This matter of the File Wrapper and Contents of the Patent-in-Suit is considered at length and with numerous quotations in the affidavit of Respondent's expert, Phillips Abbott, beginning at fol. 211, on page 126 of the Record; also more briefly in Mr. Newbury's affidavit beginning page 109, fol. 182.

THIRD. The prior art also forbids any broader construction being placed upon these claims.

The Circuit Court of Appeals, in referring to the prior art, at page 151 of the Transcript of Record, said:

> "The patent, so far as concerns the employment of the springs, is for an invention which is intended to diminish the end vibration or oscillation of the car-body, known as "galloping," when moving over the track, and which in the long cars having a comparatively short wheel-base is especially obnoxious. Its distinguishing feature is the employment of two kinds of springs, spirals for supporting the car-body above the axle boxes, and elliptic for supporting it at the ends. Brill was not a pioneer in the use of springs for this purpose. Among the patents granted before the filing of the application for the

Patent-in-Suit, the two in the prior art showing the nearest approximation to the invention of Brill are No. 409,993, granted August 27, 1889, to Benjamin F. Manier, and No. 419,876, granted January 21, 1890, to Edgar Peckham. Manier's patent describes the employment of springs for the purpose of obviating the rocking or oscillating movement of the car-body. The specification contains this statement: 'Preferably I employ spiral springs G, as shown in Fig. 1, for supporting caps I; but, if desired, the elliptical springs g could be employed, as shown in Fig. 3; or other forms of springs may be used, as found convenient and desirable, the particular form of spring not forming a part of the present invention.' This patent shows every element of the first claim of the Patent in-Suit broadly considered, except the conjoint use of spiral and elliptical springs, one of the drawing showing spiral springs only, and the other showing elliptical springs only. The patent does not show the combination of the second claim because the saddles are absent.

"The invention in the prior patent to Peckham 'consists in a novel construction of a car-truck designed to afford spring supports under the end portions of the car-body as well as the axles, and thus support said body nearly throughout its length and also obviate in a great measure the vertical oscillation of the same when moving over an undulating track.' The specification describes the spiral axle-box springs of the Patent-in-Suit, and 'suitable springs' for supporting the car-body at the ends 'which may be either of the spiral species, as shown at *t t*, or of the so-called semi-elliptical form, as shown at *t*' in Figs. 4 and 5 of the drawings, which latter form of spring is disposed cross-wise of the truck and rests with its ends in suitable shoes.' It also shows saddles mounted like those of Brill upon the axle-boxes. Of this patent the expert for the Complainant makes this statement: 'While the construction shown in this Peckham patent clearly does not embody the combination recited in the several claims of the Brill Patent-in-Suit, and while the Peckham patent contains no indication that any advantage would be attained by the use of a semi-elliptic spring across each end of the car in conjunction with spiral springs supporting the car-body over the journal boxes, I am inclined to think that the construction embodying the semi-elliptic springs would measurably attain the result that is attained by the

conjoint use of the spiral and elliptical springs, as embodied in the Brill truck, and that a car having the truck structure shown in Figs. 4 and 5 of this Peckham patent would be less liable to excessive longitudinal oscillation than any of the trucks of the prior art heretofore considered.'

"It thus appears that it was old in the prior art to employ for the purpose of obviating the oscillation of the car-body all the parts enumerated in the first and second claims, except the two kinds of springs in the same car-truck, and that the only novelty in the inventions of those claims, details of construction being disregarded, consists in the substitution of both spiral and elliptical in the place of either spiral or elliptical springs. Indeed, the inventions are wanting even in this measure of novelty, and reside merely in the substitution of elliptical for the semi-elliptical end springs. The claims are not limited to longitudinal end springs, as the specification points out they are only preferably employed; and the circumstance that the semi-elliptic springs of the Packham patent extend transversely instead of longitudinally is, therefore, immaterial."

This statement as to a portion of the prior art correctly sets forth what is disclosed by the two prior paents referred to and is in line with the statements made by Respondent's experts, Abbott and Newbury.

Referring to the substitution of elliptics for semi-elliptic springs and their arrangement, Mr. Newbury, at page 112, fol. 187 of the Record, says:

"It is a well known fact to persons skilled in the art of springs, that the action of semi-elliptic springs is identical in kind and character to that of full elliptics; in fact, it must be so since a full elliptic is simply two semi-elliptics. From this it follows, when semi-elliptic springs are used, as in this Peckham patent, No. 410,876, it would be in effect, so far as the character of their action is concerned, substantially the same as if full-elliptic springs were employed, as shown in the Brill Patent-in-Suit.

"In this connection it is to be borne in mind that this Brill patent, page 1, line 66, *et seq.*, states that the elliptic springs preferably are arranged longitudinally of the truck; and if this is the case, then it is permissable to place them crosswise thereof, as

the semi-elliptic is placed in the Peckham patent, and such an arrangement would be as fully within the Claims 1 and 2 of this Brill patent, as if they were arranged longitudinally of the truck.

"The mere term 'elliptical spring' does not imply a spring having a different kind of action from a spiral spring, because a single-leafed elliptical spring has substantially the same character of action that a spiral spring has; but the addition of more leaves to this single-leaf elliptic spring changes its character of action to the extent that the rubbing action between the adjacent leaves cause fricion, which has to be overcome, both in the compression of the spring and its expansion, and this is true whether the springs be of the elliptic form, semi-elliptic, quarter-elliptic, or straight form."

It is obvious that no construction other than that adopted by the Circuit Court of Appeals can be placed upon Claims 1 and 2 of the Patent-in-Suit, and that any atempt to do so must result most disastrously to the Petitioners as it would compel a finding that the claims are void.

We insist that Claims 1 and 2 are void because *anticipated* by the Peckham Patent 419,876.

Respondents' Car Trucks Described.

The Court below having correctly construed the claims in suit, it becomes necessary next to consider whether the Court correctly held that the Respondent's trucks did not fall within the claims thus construed.

The structure of Respondents' three trucks, known to the trade as the "Excelsior," "Standard," and "Extra Long," designed for short, medium and extra long car bodies, are tolerably well shown opposite page 45 of the Record. This page is a reproduction of an advertisement of the Respondents' Company, and from it, particularly when aided by the models of the "Excelsior" and "Standard" trucks, which will be before the Court, their structure can accurately and easily be understood.

Leaving out of consideration, the parts which are common to all car trucks, such as axles, car-wheels, truck-frame, etc., the Respondents' trucks have nothing in com-

mon with the Patent-in-Suit, except the employment of elliptic and spiral springs to support the car-body.

In the illustrations of Respondents' trucks shown opposite page 45 of the Record, the movable frame is shown at the top, between which and the truck-frame the elliptic and spiral springs are interposed. Upon this movable frame the car-body is rigidly bolted so as to become integral with it when the car is in use. For the purposes of this argument, therefore, it will be simpler if we group these two parts together under the one name of the car-body, and so this term is hereinafter to be understood. Between this car-body and the truck-frame are interposed spiral and elliptic springs, each and every one of which is rigidly held on the bottom to the truck-frame and on the top to the car-body. Thus all the springs under consideration, both spiral and elliptic, are located in the Respondents' structure as though between the jaws of a vise, to which jaws the contact ends of the springs were rigidly fastened. With such an arrangement it is obvious that when the jaws of the vise are opened all the springs must simultaneously extend as a unit, no matter how different in strength of character they may be. It is also obvious that when the jaws of the vise are screwed together, all the springs must be simultaneously compressed as a unit, no matter how they may differ in strength or character. They cannot act, one set before the other, as stated in the Patent-in-Suit and in its File Wrapper.

Just so are the springs of Respondents' trucks under consideration, placed between the car-body and the truck-frame. All are rigidly held top and bottom, and all must *simultaneously* and uniformly adapt themselves to any change in the relative parallelism or other position of the car-body and truck-frame. In all three of the Respondents' trucks near the ends, and one at each corner, a bolt, rigidly fastened to the car-body, descends through the spiral cushioning spring, passes through the truck-frame and projects underneath. Around this underneath projection of this bolt is placed a spiral spring, which bears upon the under side of the truck-frame.

The office of this underlying spring is most important.

It is the only provision in the Respondents' trucks to overcome galloping, and that is its sole function. It has no duplicate or corresponding part in the Petitioners' Truck-in-Suit. It is unique and peculiar to the Peckham trucks. It was the first method adopted by him to overcome this difficulty, and appears so far back as in his Patent No. 464,253 of December 1st, 1891. (See letter *U* Fig. 1 of that Patent.) It originated with him some years before that patent; and it, and it alone, has been his only device for overcoming galloping from that date to this.

References to the affidavits substantiating these facts will be cited later.

These underlying springs are obvious in the models and show very well in the "Standard" and "Extra-Long" trucks as illustrated opposite page 45 of the Record; but they do not appear, though equally existent, in the illustration of the "Excelsior" truck, since they are enclosed in a pocket of the lower chord of the truck-frame which conceals them. In the model, however, one side of one of the pockets has been cut away to show them.

Now note the action of these underlying springs. It has already been shown from Petitioners' own papers, that in galloping one end of the car-body goes up while the other end goes down, the ends alternating in elevation and depression just as in the see-saw of our boyhood.

Let us assume a street car in rapid motion. A low rail joint is reached. Down goes the forward end of the car while the rear end rises, or rather would rise but for the action of these underlying springs at the rear end of the car. It is obvious as the car-body begins to rise it draws up the bolts rigidly attached to it through the truck-frame, and begins to compress the underlying springs. These springs in practice are of such strength that if not compressed to their limit, the rise of the car-body from the truck-frame is so trivial as to be of no moment.

But should the tendency to rise become excessive, the underlying springs are compressed to their limit. The car-body then becomes rigidly attached to the truck-frame and can rise no further without lifting the wheels, axles, truck-frame and motor with it, and to do this the lifting power is inadequate. At the same time, the descent of the

forward end of the car-body is checked by the compression of the springs interposed between it and the truck-frame. Thus the tendency to gallop is met *simultaneously at both ends of the car.*

The eminent consulting engineer, Mr. Fowler, whose experience in testing railway appliances with instruments of precision is, perhaps, greater than that of any other man in the country, in his affidavit (Record, p. 157, fol. 18), speaking of this Peckham method, says that it was devised by Peckham while he was in Peckhom's employ prior to 1890, and that it is "the most effectual method now known and in use for overcoming the galloping motion in street cars."

Compare this common-sense mechanical structure with that of the Patent-in-Suit, which (A) opposes the tendency to gallop only by meeting and cushioning the descending end of the car, (B) leaving the other end free to do as it will; (C) which attributes the galloping in street cars to a rhythm of motion between the springs interposed between the car-body and the truck frame; and (D) relies, to accomplish its purpose upon breaking up this rhythm by the introduction of springs of varying character acting one after the other—*can any two modes of operation conceivable be more radically different?*

Mr. Peckham gives the history of this device in his affidavit, beginning page 84 of the Record. He entered into the manufacture of street car-trucks at the beginning of the substitution of electricity for horses. He was at once confronted with the problem of the unavoidable necessity of a short wheel-base, the commercial necessity of a long car body, and the galloping difficulty to which the combination gave rise (p. 85.) At first he endeavored to meet it by extending the spring-base of his truck out to the ends of the car, and tying the ends of the spring-base and of the car-body together by passing bolts from the ends of the car-body down through the truck-frame, to the under side of which they were secured. It was found that the check was too abrupt, and rubber springs were interposed between the heads of the bolts and the lower side of the truck-frame. This was an improvement and immediately suggested the substitution of spiral

springs for the rubber cushions. And upon this method, and this alone, he states that he has relied to overcome galloping from that day to this (Record, pp. 85-87).

He states, Record, p. 91, fol. 151:

> "I and my companies have made and sold eight thousand or more trucks of this construction, all of which, as far as I know, are still in use, and in regard to the efficiency of which in overcoming the galloping motion, I have had no complaints from those using them; and this is notwithstanding that these sales have extended over some eight years or more, so that there has been ample time for complaint if there was any cause for it."

Neither he, nor the Respondent Company, nor any company with which he has been connected, has ever made any four-wheeled street car-truck in which any other means than this underlying spring has been relied on to overcome galloping (Record, p. 88).

He describes its mode of operation as above, on pages 86-87, of the Record, and concludes with these words:

"Thus it will be seen that I have attacked the problem from one direction, while Mr. Brill, Complainant's Patentee, attacked it from a wholly different, and, as I have always believed, mistaken direction."

Mr. Fowler, who was then in Mr. Peckham's employ, and who installed the Peckham works at Kingston, New York, corroborates this. He gives this history of this device and its mode of operation at length (see Record, pp. 93-94).

The construction, mode of operation and efficiency of the Peckham underlying spring method of overcoming galloping, is confirmed by the following affidavits on the part of the Defendants:

Newbury (Record, p.44, fol. 191);

Abbott (Record, p. 115, fol. 192).

McGowan was for ten years master mechanic of the Third Avenue Railway, and until the spring of 1900. He had 175 Brill (Bemis), and substantially an equal number of Peckham's trucks of the "Excelsior"type, in use on the same tracks at the same time. All the Peckham

trucks had the underlying anti-galloping springs. When the change from cable to electricity was made on that road, all the Brill (Bemis) trucks were thrown into the scrap heap, while all the Peckham trucks were supplied with electric motors and are still in satisfactory use. He describes the superior efficiency of the Peckham trucks, as demonstrated by their use, side by side with the Brill trucks (Record, pp. 101-102).

Beetem, general manager of the Queens County Railway, has been manager of the Atlantic Avenue Railway of Brooklyn, the Scranton Railway and Union Traction Company of Philadelphia, for ten years; and before that was engaged in the manufacture and sale of cars and trucks for steam railways; has used both Brill's and Peckham's trucks; and describes the truck of the Patent-in-Suit (Record, p .103). He states that electric cars are usually from twenty-six to thirty feet long and limited to a seven foot wheel-base, outside which the car ends projcet from eight to ten feet. When running eight miles an hour, a car will gallop at depressions in the track "unless the rear end of the car-body is tied down to the truck-frame so that it cannot rise." In Brill's trucks the car-body is not so secured.

He describes the construction of Peckham's trucks, the underlying springs, and their action. These springs and their allied bolts tie down the ends of the car body so that they cannot rise, and therefore cannot gallop, without lifting the wheels, axles, truck and motor, which it lacks the power to do (Record, p. 103).

> "With proper care to regulate the under tension springs, a Peckham truck of the 'Extra Long' type will run at a speed of fifteen to twenty miles an hour on an ordinary road bed with very slight oscillation; while the Brill truck referred to in this suit, having a shorter spring base and no provision to hold the ends of the car-body firmly to the truck-frame, will not run ten miles an hour without excessive oscillation." (Record, p. 104, fol. 173.)

RESPONDENT'S ELLIPTIC SPRINGS AND THEIR FUNCTION.

Mr. Livermore, Petitioners' expert (Record, p. 71), states:

"It seems obvious that there is no reason for adopting the elliptical springs in these Peckham trucks other than in order that they may co-operate with the spiral springs in order to prevent excessive endwise oscillation or galloping movement of the car-body, the same as is done by the like combination of elliptical and spiral springs in the specific arrangement shown in the drawings of the Brill patent."

In view of other parts of this gentleman's affidavit, it is obvious that he means that the sole office and function of Peckham's elliptical springs is to embody the Brill idea of breaking up the alleged rhythm of the spring system.

It is singular that a mind so acute as to evolve from its inner consciousness, and without the aid of any practical experiment or demsonstration whatever, this remarkable rhythm theory, should, in the absence of an attack of paresis, be unable to see the plain and obvious function of the elliptic springs in the Peckham construction.

It is to be borne in mind that Peckham employed the combination of semi-elliptic and spiral springs for the avowed purpose of overcoming galloping in his prior patent No. 419,876, which was cited against the Patent- in-Suit in the Patent Office, and replied to by the Applicant, Mr. Brill, thus admitting it to be part of the prior art.

The truth of the matter is this, as is conclusively shown by Defendants' affidavits and mechanical common sense.

Prior to 1890, and when Peckham first began to build these car-trucks, all the springs interposed between the car-body and truck-frame were spiral springs. Bolts passed downward through these spiral springs connecting the car-body to the truck-frame. The connection of these bolts to the truck-frame was necessarily a loose connection; that is, in order that the spiral springs might act and cushion the car-body, it was necessary that these bolts should move up and down through their holes in the truck-frame. This gave a sort of pivotal connection between the car-body and the truck-frame. That is, the bearing of these bolts in the truck-frame was so short, and necessarily so loose, that the upper part of these bolts where connected with the car-body could move quite a distance laterally as though on a pivot. Thus the car-body when pushed upon by the hand could be made to

sway sidewise three or four inches. This gave rise to a very objectionable swaying motion of the car-body when in operation. Prior to 1890, and while Mr. Fowler was still with Mr. Peckham, the introduction of elliptic springs in place of some of the spirals was decided on to overcome this difficulty. It was obvious that if broad, flat springs like elliptics were introduced and tied firmly both to the truck and the car-body, that this motion could not occur without the simultaneous tortion of all of the elliptic springs, and this the severest stress possible in use was insufficient to effect. In this way the swaying effect was overcome; and it was for this purpose, and this purpose alone, that elliptic springs were introduced into the Peckham trucks; and it is for this purpose, and this purpose alone, that they have been used therein down to the present day.

All this is abundantly shown by the affidavits of Peckham, Fowler, Beetem, Newbury and Abbott.

As far as the galloping motion is concerned, the practical experimental demonstrations, immediately hereinafter described, show beyond question that the introduction of the elliptic springs into the Peckham Trucks is a positive detriment; the amount of galloping being the same, while the motion is much easier on both passengers and car when all spiral springs, without any elliptics, are used.

THE RESPONDENTS SUBMITTED THE DETERMINATION OF THESE QUESTIONS TO EXPERIMENT, AND THE RESULTS.

On page 1 of the specification of the Patent-in-Suit on lines 93-101 and page 2 lines 1-6, it is stated in substance, that in the prior art all spiral springs had been introduced between the car-body and the truck-frame, but that this arrangement was not satisfactory in overcoming oscillation.

It was also noticed that Complainants' expert, Mr. Livermore, deposed (Record, bottom p. 79):

> "That the employment of spiral springs alone is inadequate for checking or preventing the longitudinal oscillation (galloping), although perfectly efficinet, so far as the performance of all other func-

tions of a spring support for a car-body is concerned."

And this idea appeared to be re-echoed elsewhere in Petitioners' affidavits, and notably by Akarman, as quoted in Judge Shipman's Decision in the Third Avenue Case. Record, p. 139.

The Respondents reasoned as follows:

That all of these matters in reference to the functions of the springs, and whether they operated according to the theories of the Petitioners or the belief of the Respondents; and incidentally whether Respondents' trucks did really embody the alleged invention of the Patent-in-Suit; were susceptible of absolute, practical demonstration.

It was reasoned that if a Peckham car was obtained, one having the shortest possible wheel-base combined with the longest possible car-body, and if Peckham's elliptic springs were removed and spiral springs of equal tested strength were substituted; and if this car was supplied with automatic registering apparatus which would measure and record its oscillations and speed together with the simultaneous indications of a chronograph; that the amount of oscillation could be determined absolutely at any second time; and that if this car were run at a high rate of speed over a rough track, that the parts respectively played by the spiral and elliptic springs would be a matter of demonstration, and no longer a matter of guess work.

Then, after these experiments were completed and this record obtained, if Peckham's elliptic springs were restored to their original position and the car again run over the same track at the same rates of speed, if Complainants' theory was correct and if Peckham's elliptic springs performed the functions Complainants alleged the Brill elliptics performed, then the galloping with all spiral springs should be far in excess of that shown when Peckham's combination of elliptic and spirals was used.

This was done.

Mr. Fowler, whose skill and experience in testing rail-

way appliances with automatic instruments of precision is recognized among railway men in this country as second to none, was employed to conduct these tests. The use of a Peckham "Extra Long" car-truck, with its superposed car-body was obtained, and placed in Mr. Fowler's charge to be fitted up with such registering appliances as were required. This car had a six and a half foot wheel-base and was thirty feet ten inches long over all. This gave an overhang of over twelve feet at each end. The use of the tracks running from Ninety-fourth street ferry to Thirty-fourth street ferry, in Astoria, was obtained. This locality was peculiarly fitted for these experiments, since the track was old and unusually rough, and the street was wide and little used, so that high speed was possible with safety. The length of the course was three miles down on one track and three miles back on the other track, making about six miles for each round trip. Of these experiments, Mr. Fowler says (Record, p. 96, fol. 159):

> "The nature of these experiments was of such a character that all matters governed by the personal equation of the observer were eliminated, and the action of the car was graphically shown by the operation of the instruments used upon a moving strip of paper, upon which was automatically recorded the rate of speed of the car and the galloping motion of the ends of the car, in such a way that both of these could be positively and accurately determined at any and every half-second interval while the car was in motion."

Four round trips were made with the car equipped with all spiral springs; and four round trips were made over the same tracks at the same rates of speed with the elliptic springs restored; that is, with the Peckham "Extra Long" truck, as it is shown in Complainants' illustration of Peckham's Extra Long Truck, opposite page 45 of the Record. The first two trips with the all spirals were made at the highest speed that it was possible to attain, far in excess of the running schedule of the road. The third round trip with the all spirals was made as near as possible on schedule time—thirteen and a half miles an hour. The fourth round trip with the all spirals was

made at the slower speed of nine miles an hour. The car was then taken to the shop, the elliptic springs replaced, brought back to the course, and four precisely similar trips were made with it.

The results were as follows:

Mr. Fowler states, page 97 of the Record, fol. 161:

> "I am in a position to state positively that the oscillations of the car when the spiral springs alone were employed, and when spiral and elliptic springs were conjointly used, were substantially the same throughout the whole series of tests.
>
> "But there was a marked difference noticed in the character of the movements. * * * When all spirals were used the movements were smoother, more even, less tremulous, less abrupt than when the elliptics and spirals were conjointly used. Thus the riding of the car when the all spirals were employed was * * * smoother and more comfortable than when the spirals and elliptics were conjointly employed. This difference in smoothness or comfortableness of the car motions was noticed and referred to by all the gentlemen who were upon the car with me at the time these tests were made, among whom were Mr. Newbury and Mr. Abbott."

When driven at the highest rate of speed:

> "The maximum galloping movement of the all spiral spring car was one and nine-sixteenths (1 9-16) inches. The maximum galloping movement of the same car provided with elliptical and spiral springs as aforesaid nas one and one-half (1 1-2) inches, a difference of one thirty-second (1-32) of an inch at each end of the car-truck at the point where my instruments were attached, a difference entirely unappreciable except by the delicate instruments I used in making these measurements. (Record, p. 97, fol. 161).

At nine miles an hour the galloping was practically nothing.

> "When the speed was increased to that of the regular running rate, that is, approximately thirteen and a half (13 1-2) miles an hour, the average galloping was barely perceptible in each case, and so

nearly the same with both equipments that, though shown by my instruments, the difference would have been imperceptible to a passenger" (Record, p. 98, fol. 163).

At this rate of speed the maximum gallop of the all spirals was one and five-eights (1 5-8) inches; with the elliptics and spirals one and three-quarter (1 3-4) inches; but each was but a single momentary incident.

These experiments are described in detail by Mr. Fowler in his affidavit, beginning at page 132 of the Record.

They are described by Mr. Newbury, who took part in them, in his affidavit, page 116, etc.

On page 117, Mr. Newbury says:

> "From my own observation of the records of the movements of the car I know that the extent of the oscillations of the ends of the car was substantially the same in both series of tests, and this fact can be made plain from the records which were taken.
>
> "There was quite a marked difference in the character of the oscillations of the ends of the car in the two series of tests."

With all spirals the movements were more gradual and easier; with elliptics and spirals, the oscillations were more quick and jerky, and "much the harder riding of the two."

Mr. Abbott, who also took part in these experiments, describes them on page 132 of his affidavit. He states the car used was a Peckham's "Extra Long," as shown opposite page 45 of the Record. He says:

> "The same car was used in both portions of the tests, the spiral springs being substituted in one portion of them for elliptic springs used in the other portion; and the loads and speeds were the same in both series of tests. From my personal and careful observation of the running of the car, and also from personal observation of the operation of the appratus used to record the oscillation, I know and unqualifiedly state that the oscillations of the car and its general motions while running at high speeds, at medium speeds, and at slow speeds, were at least no more in extent when the spiral springs were em-

ployed throughout, than when the elliptical springs were used in conjunction with the spirals; indeed, I distinctly noticed that the car motions were smoother and more comfortable when all spirals were used than when the spirals and elliptics were used" (Record, p. 221, fol. 47-48).

These experiments would seem to demonstrate conclusively that Peckham's elliptic springs do not perform the function claimed for the elliptic springs of the Patent-in-Suit. Indeed, as far as galloping goes, their introduction into the Peckham truck is demonstrated to be a positive disadvantage; and the only beneficial function they can perform—the only reason for their continued use all these years is that stated by the Respondents; *i. e.*, to prevent the lateral swaying of the car-body.

The Petitioners tendered this issue to Respondents—whether or no the Respondents' trucks embodied elliptical springs slower in action than the spiral springs. To maintain the affirmative of this issue, their expert, Mr. Livermore, Record, pp. 68-69), stated:

"That is, there are two sets of springs, differing in character and in the quickness of action, so that each tends to give a different period of oscillation of the car-body from the other, and thus the effect of one set of springs tending to produce a constantly increasing amplitude of oscillation if the car should be acted upon by a series of impulses, such, for example as in passing over the consecutive rail points, is neutralized by the other set of springs, which are of such character as not to produce a period of oscillation in harmony with the said impulses.

"The two classes of springs employed in the Peckham trucks are of the same specific kind as those shown in the Brill patent, one class being composed of spiral springs, so arranged as to have the weight of the car-body distributed over them, and the other springs are elliptical springs, which are slower in action than spiral springs, and are placed between the car-body and the end extensions of the side beams of the indepedent frame, where they are most effective in tending to check vibrations, and thus to prevent the car-body from acquiring a longitudinal oscillation or galloping movement."

The Respondents accepted the test, and their proofs (heretofore referred to), to sustain their contention that both sets of springs are brought into action and compressed simultaneously, were so overwhelming that the Court found:

> "In the car-trucks of the Defendant both sets of springs are brought into action, and begin to compress simultaneously when the weight upon them is greater than the normal weight of the car."

THE CIRCUIT COURT OF APPEALS' FINDINGS ON CONSTRUCTION OF CLAIMS AND INFRINGEMENT CORRECT.

An examination of the record cannot fail to convince this Court that the Court below correctly construed the Claims 1 and 2 and correctly held that the Respondents' trucks did not infringe the claims so construed. The Court had before it, in reaching its conclusion, not only the usual affidavits upon motions for injunctions, but had the light thrown upon the controversy by the complete record in another case upon the same patent. The Petitioners did not ask the Circuit Court for leave to file supporting proofs, as they could have done under Rule 107 of the Second Circuit. It is not thought that this Court will disturb the finding of the Court below upon the question of the construction of the claims and the non-infringement of such claims by the Respondents' trucks. The Court below could not escape granting an order vacating the preliminary injunction.

We are now brought to consider what seems to us to be the only question deserving serious consideration, and that relates to the dismissal of Petitioners' bill of complaint.

SECOND.

WAS THE CIRCUIT COURT OF APPEALS JUSTIFIED IN DISMISSING THE PETITIONERS' BILL OF COMPLAINT?

At the outset it may appear that it is somewhat drastic to dismiss a bill of complaint upon the hearing of a mo-

tion asking for a preliminary injunction, or upon an appeal vacating an injunction order, but this Court has determined that in a proper case a Circuit Court of Appeals is justified in so doing. (Mast. Foos & Co. *vs.* Stover Mfg. Co., *infra.*) It may be difficult to lay down any rule on this subject which will fit all cases, and it may be that each case should be governed in its determination by its peculiar facts, and the law applicable thereto. The Circuit Court of Appeals did not act hastily or without due consideration when it held that "the case is one in which it is apparent that the Complainant cannot ultimately prevail, and, following the practice sanctioned by Mast, Foos & Co. vs. Stover Mfg. Co., 107 U. S., 485 * * * one in which the bill should be dismissed." As has been heretofore said, the Court of Appeals heard the case not only upon the usual affidavits, but upon the record made up for final hearing in a former case. The Court, in considering and construing Claims 1 and 2 of the patent, decided a question of law. It carefully considered the specification, and nad before it the file wrapper and contents of the application upon which the patent issued, and sufficient of the prior art to warrant its conclusion that the claims referred to should be limited to a combzination of spiral and elliptic springs, so arranged that the elliptics are not brought into action until the spirals have begun to compress. In comparing Respondents' trucks with the claims as construed, it had, on the one hand, the sworn statement of Mr. Livermore that the elliptical springs of Defendants' trucks were slower in action than the spiral springs. Against this it had the sworn statements of Messrs. Peckham, Newbury, Fowler and Abbott that both sets of springs were brought into action and began to compress simultaneously. These latter statements were based upon a series of carefully authenticated tests. The Court of Appeals was confronted and naturally carefully considered the opinion rendered by the decision, in a previous case, of one of its own judges by him. Furthermore, after having given one hearing and a careful consideration to the controversy, it granted a rehearing, where the propriety of dismissing the complaint was brought to the attention of the Court, and after due consideration it affirmed its former order.

If, from the standpoint of the Petitioners, it may appear to them that the action of the Circuit Court of Appeals was drastic, it may be said in reply that they have no equities in their favor. The Patent-in-Suit was granted in 1892. It was not until the fall of 1897 that the Respondents' attention was called to the patent, and though suit was threatened it was not brought against them. It is true that in the fall of 1897 a suit was brought against a street railway company for using another form of truck, made by another builder. That suit was allowed to drag for three years before it came on for final hearing. During those eight years the Respondents had placed upon the market some ten thousand trucks of the styles complained of. Have the Respondents no cause to complain of Petitioners' laches? If this Court reverses so much of the order of the Circuit Court of Appeals, as directed, a dismissal of the bill of complaint, will not this action be more drastic than that of the Circuit Court of Appeals in dismissing the complaint. A patent with twenty-eight claims in the hands of a litigious and powerful corporation may, and often does, mean ruin to a defendant, no matter what the result of the litigation may be. This Court knows what so-called "equity proceedings" in a patent cause mean. What good can come from reopening the case? There is not one chance in a thousand that the Circuit Court will find for the Petitioners if this case is sent back, and there is not one chance in a hundred that the Circuit Court of Appeals will overrule itself. Notwithstanding all this, the Respondents will be put to an enormous expense in defending their position upon questions that have already been carefully passed upon by the Circuit Court of Appeals. The Court is not asked to lay down any general rule to apply to all cases. It can confine itself to the case at bar. It should not lightly exercise its authority, for this is not a case where there is the necessity of avoiding conflict between different Circuit Courts of Appeal, nor is it a matter that affects the interests of any other than the parties themselves or those holding under them. It will not be a bar against a suit on any of the other claims. It will make such a suit less expensive for all of the parties.

With this general statement a more specific answer will be made to what are supposed to be the reasons to be urged by the Petitioners why they should have another day in Court in the present suit.

Petitioners' Reasons Why the Bill of Complaint Should Not Be Dismissed, and Respondents' Answer Thereto.

Petitioners, upon their petition for the writ of certiorari herein, urged that they were entitled to take testimony upon the following points:

"I. The actual construction of the Defendants' various trucks, as they have made and sold them from the time they began to manufacture trucks containing the combination of spiral and elliptical springs of the Patent-in-Suit."

The actual construction of Defendants'-Respondents' trucks is shown by the illustrations offered by Petitioners, by the models offered by Respondents, and by other proofs. There is, and can be, no dispute as to the "actual construction" of Respondents' trucks. No amount of evidence can alter the admitted facts. Reams of paper may be filled with testimony and the parties put to infinite expense, to no purpose. They state that they wish to show this construction covering the entire period of Defendants' manufacture, which is shown to be ten years. To permit this, under the circumstances of this case, would be a travesty upon justice.

"II. The actual operation of the Dedendants' devices as compared with the devices of the Patent-in-Suit."

As has been stated, this issue was tendered by Petitioners, met by Respondents, and decided by the Circuit Court of Appeals. To recognize this request would be in fact to permit the case to be reopened, simply because Petitioners' proofs were insufficient to prove their case, and without giving any valid reasons permitting them to give additional proofs. If their assertions that they desire to take testimony upon this point are true, they should nevertheless be relegated to a new suit. The decision of the Court below settled the construction to be placed upon

Claims 1 and 2, unless this Court decides that it will overrule the Court below. It settles nothing as to the construction of the other claims, or whether Respondents' have infringed them. The questions that have been heretofore passed upon should be considered settled once for all. Petitioners made no effort to controvert Respondents' affidavits. They did not ask the Court below for leave to file replying affidavits, as they might have done under Rule 107 of the Circuit Court for the Southern District of New York, which reads as follows:

> "Rule 107. Suppletory, or supporting, proofs may, at the discretion of the Court, or judge, be offered by the Complainant, to rebut the cause as shown by the Defendant; but the reception of such additional proofs is not to permit the introduction of further proofs in opposition thereto, by the Defendant, previous to the final hearing upon the merits."

The truth is that they could not controvert Respondents' affidavits, and now only wish to prolong this suit, using it as a club against Respondents. To quiet litigation, this Court should frown upon the attempt to harass and annoy the Respondents in the manner shown by this proceeding. We are justified in urging the equities for the animus of the Petitioners in bringing this suit is shown by the fact that they not only made the manufacturing company defendant, but also its officers and directors, without alleging any just cause for so doing.

"III. The question whether the Defendants' devices do, *in fact*, infringe Claims 1 and 2, if said claims are to be limited, as held by the Court below."

This is in substance Petitioners' second reason, and the answer to it is the same as to that reason.

"IV. The question whether Defendants' trucks do, *in fact*, infringe other claims of the Patent-in-Suit (e. g., Claims 9, 10, 11 and 14, which have been sustained by Judge Shipman)."

This is an assertion that they desire to try the question of infringement of certain claims which were passed upon by Judge Shipman, in the Third Avenue Railroad Company suit, and stand on a parity with Claims 1 and 2. Does this Court for a moment believe that had Petition-

ers believed that Claims 9, 10, 11 and 14 were infringed by Respondents' trucks, they would not have asked for an injunction against them, as well as against Claims 1 and 2? They based their right to an injunction as to Claims 1 and 2 upon the doctrine of comity, and that doctrine certainly would have been as persuasive as to the other claims which they now profess they wish to litigate in this suit. Their present position as to such claims is an afterthought, and a mere subterfuge by means of which they wish to get this case reopened and the Respondents forced into a ruinous litigation. If they wish to contest the question of the validity and infringement of these claims, let them bring a new suit. Such suit would be within narrow limits, and easily disposed of. Very different from this, if the doors are thrown wide open and all the questions that have been carefully passed upon by the Circuit Court of Appeals are to be again gone over.

The Circuit Court of Appeals, to an extent, considered all the claims of the patent, but not so far as to create an estoppel against Petitioners. The Court said (Record, pp. 151-152):

> "We do not overlook the consideration that in other claims of the patent this functional characteristic of the invention is made a limitation in terms. Those claims, however, differ in other respects from the two claims in controversy. There are 28 claims in all, and some of them are merely duplicates of others, varying the phraseology, but not in substance. They were obviously framed to cover any possible theory of the invention which is hinted at in the specification, and which the exigencies of an infringement action may require."

"V. The question how the devices of the Peckham patent, No. 410876, would operate, if used, and whether they necessarily limit the complainants' patent in the manner adjudged by the Circuit Court of Appeals."

This reason is without merit. The Peckham patent referred to shows a structure which clearly anticipates Claims 1 and 2, unless they are limited, as they were by the Court below. The patent speaks for itself, and as to how a device constructed thereunder would operate

is immaterial as to any possible issue in this suit. Had the Court below held that this Peckham patent anticipated Claims 1 and 2, then the method of its operation might be a material question. The attention of this Court is again called to what the Circuit Court of Appeals said in referring to this prior Peckham patent, including Complainants' expert's statement.

[redacted]

"This invention in the prior patent to Peckham 'consists in a novel construction of a car-truck, designed to afford spring supports under the end portions of the car-body, as well as the axles, and thus support said body nearly throughout its length, and also obviate in a great measure the vertical oscillation of the same when moving over an undulating track.' The specification describes the spiral axle-box springs of the Patent-in-Suit, and 'suitable springs' for supporting the car-body at the ends 'which may be either of the spiral species, as shown at tt, or of the so-called semi-elliptical form, as shown at t', in Figs. 4 and 5 of the drawings, which latter form of spring is disposed crosswise of the truck, and rests with its ends in suitable shoes.' It also shows saddles mounted like those of Brill upon the axle-boxes. Of this patent the expert for the Complainant makes this statement: 'While the construction shown in his Peckham patent clearly does not embody the combination recited in the several claims of the Brill Patent-in-Suit, and while the Peckham patent contains no indication that any advantage would be attained by the use of a semi-elliptic spring across each end of the car in conjunction with spiral springs supporting the car-body over the journal boxes, I am inclined to think that the construction embodying the semi-elliptic springs would measurably attain the result that is attained by the conjoint use of the spiral and elliptical springs, as embodied in the Brill truck, and that a car having the truck structure shown in Figs. 4 and 5 of this Peckham patent would be less liable to excessive longitudinal oscillation than any of the trucks of the prior art heretofore considered.'

"It thus appears that it was old in the prior art to employ, for the purpose of obviating the oscillation of the car-body, all the parts enumerated in the first and second claims, except the two kinds of springs in the same car-truck, and that the only novelty in the inventions of those claims, details of construction being disregarded, consists in the substitution of both

spiral and elliptical in the place of either spiral or elliptical springs. Indeed, the inventions are wanting, even in this measure of novelty, and reside merely in the substitution of elliptical for the semi-elliptical end springs. The claims are not limited to longitudinal end springs, as the specifications points out they are only preferably employed; and the circumstance that the semi-elliptic springs of the Peckham patent extend transversely instead of longitudinally is, therefore, immaterial."

"VI. That the devices of the said Peckham patent were, and are, *in fact*, incapable of practical use, and that they were never, in fact, used."

It is entirely immaterial whether or not the truck of the prior Peckham patent is or is not capable of practical use. It shows and describes a structure which meets the terms of Claims 1 and 2 of the Patent-in-Suit, unless they are limited, as they have been. It shows a combination of spiral and semi-elliptic springs, with the other elements of the combinations of Claims 1 and 2 of the Patent-in-Suit, and, therefore, to escape it was necessary to limit such claims to operate as described in the specification of the patent.

"VII. The question whether the Complainants' invention antedates the said Peckham and Manier patents."

There is no necessity for any testimony to be taken upon the question whether the invention of the Patent-in-Suit antedates the Peckham and Manier patents. The Manier patent was applied for June 21, 1889, and issued August 27, 1889. The Peckham patent was applied for September 2, 1889, and issued January 21, 1890. Brill conceived his invention in May, 1889, made rough sketches of it. G. M. Brill, the inventor, in his testimony in the Third Avenue Railroad Company suit, referring to the time when he was in Cleveland on November 14 and 15, 1890, says: "that is the time that I brought my ideas into practical use and ordered our people to make the truck." (Record, Third Avenue Railroad, p. 134.) He did nothing further with it until November, 1890.

Upon this state of facts, which certainly is as favorable to Petitioners as any state of facts that could be developed, it becomes a question of law whether or no the

Manier and Peckham patents antedate the Brill invention.

Admitting that Brill was the first to conceive and disclose to another the invention of his patent, it appears that he did nothing further for a year and a half. Meanwhile, Manier and Peckham had applied for and received patents—Manier as early as August, 1889, Peckham as early as January, 1890. While it is true that the first to conceive and disclose is entitled to a patent, provided he is diligent in reducing to practice, he loses his right if during his delay others make their inventions and receive patents therefore. The rule of law is so well established that citation of authorities is deemed unnecessary. Furthermore, the Peckham patent was cited as a reference in the Patent Office against the Patent-in-Suit, and, that it belonged to the prior art was admitted by Brill's attorney in making no assertion of priority and in treating it as a part of the prior art. This was not done ignorantly, for the file wrapper and contents of the Brill application shows that his attorney knew how to antedate patents cited as references, swearing back of them.

"VIII. The utility and value, as well as the wide adoption and use, of the combination of Claims 1 and 2 of the Patent-in-Suit, consisting essentially of spiral and elliptical springs combined with the side beams and movable frames of a car-truck, the said elliptical springs being of slower action and of a different period of action from the spiral springs, as showing patentable quality in the invention, regardless of the relative times at which one spring or the other comes into use."

The testimony upon the point above stated is immaterial. The utility and value of the device of a patent cannot confer patentability upon it. Invention cannot be predicated upon the popularity of a device. (McClain vs. Ortmayer, 141 U. S., 419.)

"IX. That the Defendants' trucks are *not*, as claimed by the counsel for Defendants, the Peckham Company, in his argument against the petition for rehearing in the Court below, 'radically different, both in construction and mode of operation, from that of the Patent-in-Suit," such allegation being based upon *ex parte* affidavits relating chiefly to certain alleged experiments conducted by wit-

nesses for the very purpose of this case, to which affidavits your petitioners were not permitted to reply in the Record now before the Court."

This reason contains a misstatement of fact. The Petitioners were not refused permission to reply to Respondenst' affidavits. Rule 107 of the Circuit Court, before referred to, provides that permission can be given by the Court. Such permission was not asked, and presumably was not desired by Petitioners. Our answers to the other reasons are pertinent, and sufficient for answer to this.

In conclusion, it is respectfully submitted that there was no error in the decision of the Circuit Court of Appeals, and the order should be affirmed.

Respectfully submitted,

CHARLES H. DUELL,
WILLIAM A. MEGRATH,
Of Counsel for Respondents,
220 Broadway, New York City.

New York, February 21, 1903.

NOTE.—Mr. Henry P. Wells, who ably represented the Defendants in the Court below and upon the petition for the writ of *certiorari* herein, was compelled by reason of ill health to retire from practice and the case was transferred to us. We have largely utilized his brief in the Court below and beg leave to call the attention of the Court to his brief for Respondents' filed in this Court on the hearing of the petition for the writ.